

FILE COPY

FILED

SEP 17 1946

**CHARLES ELWORE DROPLEY
CLERK**

**IN THE
Supreme Court of the United States**

OCTOBER TERM, 1946

NO. 515.1

**WHEELING STAMPING COMPANY and BURRASON
CORPORATION, Petitioners,**

v.

**STANDARD CAP AND MOLDING COMPANY,
Respondent.**

**PETITION FOR WRIT OF CERTIORARI AND
PETITIONER'S BRIEF IN SUPPORT THEREOF.**

✓
**WILLIAM H. PARMELEE,
EIFFEL B. GALE,**

Counsel for Petitioners.

**CHRISTY, PARMELEE & STRICKLAND,
1621 Farmers Bank Building,
Pittsburgh, Pennsylvania,**

**EDWARD A. SMITH, ESQ.,
802 Union Trust Building,
Baltimore, Maryland,**

Of Counsel.

September 14, 1946.



INDEX.

	PAGE
Petition for Certiorari	1
Summary and Short Statement of the Matter In- volved	1
Jurisdiction	7
Questions Raised by the Case.....	9
Reasons Relied on for Allowance of Writ.....	11
Brief in Support of Petition.....	15
Reasons for Granting of the Writ.....	15
The Quasi-Paper Patent Situation.....	26
Westinghouse v. Boyden Not Applicable.....	27
Conclusion	28

CASES CITED.

Davis Sewing Machine v. New Departure, 217 F. 775 (6 C.C.A.)	12, 17
Exhibit Supply Co. v. Ace Corp., 315 U.S. 126 at 138	5, 8
Galion Iron Works v. J. D. Adams Manufacturing Co., 105 Fed. (2) 943 at 947.....	23
Goodyear v. Ray-O-Vac Co., 321 U.S. 668 at 669 [136 F. (2) 159 affirmed 7 C.C.A.].....	8
Gypsy Oil Co. v. Leo Bennet Escoe et al., 275 U.S. 498	7
Hildreth v. Mastoras, 257 U.S. 27, at 34.....	26
Hobbs v. Beach, 180 U.S. 383 at 401.....	6
Hoover Co. v. Coe, 325 U.S. 79.....	8

	PAGE
Keller v. Adams Campbell Co., 264 U.S. 314 at 319..	7
McCarty v. Lehigh Valley R. Co., 160 U.S. 110, 116..	22
Milcor Steel Co. v. Fuller Co., 316 U.S. 143.....	11
Morley v. Lancaster, 129 U.S. 263 at 274, 282, 290	5, 11, 16
Morse v. United States, 220 U.S. 151, 153, 154.....	7
Muncie Gear Co. v. Outboard Co., 315 U.S. 759 at 766	8
Paper Bag Case, 210 U.S. 405 at 416, 417: 420, 423..	
.....	11, 22, 23, 26
Parks v. Booth, 102 U.S. 98 at 104.....	11
Reinharts, Inc. v. Caterpillar Tractor Co., 85 Fed. (2) 628	11
Saco Lowell Shops v. Reynolds, 141 F. (2) 587.....	11
Sinclair & Carroll Co. v. Interchemical Corp., 325 U.S. 327	8, 24
Smith v. Snow, 294 U.S. 1 at 3.....	8, 9, 11, 22
Snow v. Lake Shore R. Co., 121 U.S. 617, 630.....	22
Special Equipment Co. v. Coe, 324 U.S. 370.....	8, 11, 26
United Carbon Co. v. Binney & Smith Co., 317 U.S. 228 at 229	7, 16
U. S. Repair & Guarantee Co. v. Assyrian Asphalt Co., 183 U.S. 591 at 601.....	4
United States Chemical Co. v. Carbide & Carbon Chemical Corp., 315 U.S. 668 at 669.....	8
Waxham v. Smith, 294 U. S. 20 at 21.....	8, 9, 11
Westinghouse v. Boyden, 170 U.S. 537.....	27
White v. Dunbar, 119 U.S. 47 at 51, 52.....	4, 11, 22
Winans v. Denmead, 15 How. 330 at 343.....	11, 17, 22

IN THE
Supreme Court of the United States

OCTOBER TERM, 1946

NO.

**WHEELING STAMPING COMPANY and BURRASON
CORPORATION, Petitioners,**

v.

**STANDARD CAP AND MOLDING COMPANY,
Respondent.**

PETITION FOR WRIT OF CERTIORARI.

*To The Honorable Chief Justice and Associate Justices
of The Supreme Court of the United States:*

Your Petitioners, Wheeling Stamping Company and Burrason Corporation, Plaintiffs, respectfully pray for a Writ of Certiorari to the Circuit Court of Appeals for the Fourth Circuit to review a final judgment of dismissal of that Court entered on May 2, 1946, (R. p. 458; R. p. 2 a, Vol. 1 [D.C.]), and for which Petition for Rehearing was denied without opinion June 17, 1946, but only insofar as the Rahm patent is involved. (R. p. 493).

Summary and Short Statement of the Matter Involved.

Burrason Corporation is the owner of United States Letters Patent to Rahm, No. 1,944,571, dated January 23, 1934, and Wheeling Stamping Company is an exclusive licensee under the Rahm patent. The Petitioners filed their suit for patent infringement against Standard Cap and Molding Company of Baltimore, charging infringement of the Rahm patent, and also charging infringement of two other patents owned by the Wheeling Stamping Company, *i.e.*, Scott patent No. 2,226,326, dated December 24, 1940, and Webb patent No. 2,225,672, dated December 24, 1940.

Petitioners pray that Certiorari be granted only insofar as the proceedings involve the Rahm patent No. 1,944,571.

Claims 1 and 2 of the Rahm patent were in suit. The District Court, without passing on validity, held non-infringement. (R. p. 2 a, 3 a, 12 a [Vol. 1]; 60 F. Sup. 533 [65 U.S.P.Q. 360]). On appeal, the Fourth Circuit Court of Appeals, also not passing on validity, affirmed the District Court. (155 F (2) 6 [69 U.S.P.Q. 295]).

As we shall hereinafter more fully point out, the District Court and the Court of Appeals decided the question of non-infringement without giving effect to the claims of the patent, but rather in total disregard to the claims, and as we shall more fully show, such procedure disregards the administrative function of the Patent Office, results in a judicial re-writing of the patent contrary to any provision of the statute, and is in direct conflict with the established conception of patent

law as recognized by this Court and the Circuit Courts of Appeals from the beginning of the patent system.

The case involves no disputed facts, and no issue of fact whatever is presented to the Court by this Petition.

The Defendant, in the accused operations, used a machine built by F. J. Stokes Machine Company—which company assumed the defense of the suit—and the alleged infringing machine is referred to as the “Stokes” machine (Typed R. p. 55). The Stokes machine was brought on the market in 1940. (Typed R. p. 85).

The Rahm patent relates to removing screw threaded plastic caps from the molding machine in which they are formed. (R. p. 187 a). Before Rahm it was necessary to bodily remove a heavy, hot mold plate from the molding press and individually unscrew each molded piece by hand. (R. p. 23 a—Pl. Ex. 5 R. p. 221 a. Also Rahm patent R. p. 187 a). Rahm incorporated mechanism in the press to effect the unscrewing and ejection of the molded pieces automatically.

Rahm and his associates in Burrason Company were men of small means, financially. They exhausted their funds when they secured a patent and built the experimental machine which was successfully operated in the Court Room. It was developed in the darkest days of the depression, and they intended to exploit the patent, but could not secure required financial aid. Rahm had to seek other work. (R. p. 59 a). When Wheeling Stamping Company took a license it ordered a large commercial machine (R. p. 134 a-136 a), but because of war priorities that machine was not built at the time of trial.

Because of this circumstance, the Court of Appeals dubbed the patent a “quasi-paper patent” with “an utter lack of commercial success.” (R. p. 455).

The claims of the Rahm patent were conceded in argument to read on the Stokes machine (See also R. p. 142 a)—no question of expanding the terms of the claim is involved.* On the contrary, the Court of Appeals, in complete disregard of uncontradicted evidence to the effect that the shape of the piece determines whether a two or three-part mold is used; that in the Rahm machine either two or three-part molds could be used, (R. p. 44 a, 45 a, 171 a, 162 a, 33 a, 36 a, 41 a, 64 a), and that the Rahm machine could be used to make any piece that the Defendant's machine could be used to make, (R. p. 55 a, 56 a), catalogued and enumerated all of these differences not germane to the real substance of the invention, nor of any real significance, (Petition for Rehearing, R. p. 467), and held that the Rahm patent must be construed as though its claims were limited to these specific differences. The Court of Appeals, in its opinion said:

"Whether Stokes infringes Rahm, however, we think presents a problem of some difficulty." (R. p. 455).

Further the Court said (R. p. 457):

"While each of these differences between Rahm and Stokes when considered alone and apart may appear somewhat slender, we think taken alto-

* It was the position of Defendant that the claims, to be valid over the prior art, must be restricted beyond the scope of their terms. Our position is that the claims must be valid as granted and infringed by that which appropriates their substance, or the patent be declared invalid. The Court has no power to rewrite the claims. (See 119 U.S. 47, at 51, 52 *White v. Dunbar*,—the classic "nose of wax" case, 183 U.S. 591 at 601; *U. S. Repair and Guarantee Co. v. Assyrian Asphalt Co.*

gether in their totality, do constitute a variation between the two machines that is both substantial and material." *

In so construing and limiting the claims of the patent and disregarding and distorting the plain and unambiguous terms of the patent the Court erred as a matter of law:

- (a) Because it judicially modifies the effective scope of the claims, when this may only be done by reissue of the patent or by statutory disclaimer.
- (b) If the claims of the patent were broader than the patentee's contribution, it was the duty of the Court to the public to declare it to be invalid, and not create a situation which carves a niche from the Rahm patent to clear the Stokes machine, but leaves it valid as against the rest of the public.
- (c) If the claims of the patent are not broader than the patentee's contribution, the "patentee has rights"*** to the full unimpaired scope of the patent.
- (d) It violated the rule that the *claims of a patent, not its specification, measure the invention*. It substitutes for the claims as the measure of the patent the Court's "at large" discretion as to

* For a synopsis of the record relative to the unimportance or immateriality and insignificance of these differences see Petition for Rehearing (R. p. 485-482). Moreover, see *Morley v. Lancaster*, 129 U.S. 263 p. 282—"The question is not whether the addition is immaterial [substantial] * * *".

** *Exhibit Supply Co. v. Ace Corp.*, 315 U.S. 126, p. 138.

how broad or, restricted or limited the patent may be. The public by the "complete uncertainty" of the procedure adopted by the Court of Appeals cannot read the claim and know that it covers the certain combination defined by its terms, and the state of mind of the Court dictates the scope of the patent. If the Circuit Court be right, a patent covers the combination defined by the grant *minus* the Court's power to capriciously restrict it.

- (e) Because the differences upon which the Court relied—and which it characterized as "slender"—are shown by evidence to be merely "subordinate differences" (180 U.S. 383 at 401, *Hobbs v. Beach*), or supplementary to Rahm's invention.
- (f) In attaching any importance to the "quasi-paper patent" situation where Rahm was unable to spend more time and resources, where his experimental machine was entirely operative and was demonstrated in Court, and where no testimony reflects on the complete practical nature of the invention, and where it was shown that Wheeling Stamping Company had placed an order for a machine but could not secure it because of war priorities, all contrary to the settled law of this Court.
- (g) In condoning and approving the District Court's "first impression" prejudice arising out of the superficial dissimilarities between the patent and the Stokes machine, and plaintiff's lack of commercial success and the "short cut" trial procedure. (R. p. 47 a, 54 a, 143 a to 147 a).

Jurisdiction.

(1) This is a suit arising under the Patent Laws of the United States, Judicial Code, Sec. 24 (7), (Title 28 U.S.C. Sec. 41 (7)).

(2) The basis upon which it is contended that this Court has jurisdiction to review the final judgment of dismissal in question (Supreme Court Rule No. 38—par. 2) entered by the Circuit Court of Appeals for the Fourth Circuit May 5, 1946 (R. p. 458), Rehearing denied June 17, 1946 (R. p. 493), is Judicial Code Section 240-a as amended by the Acts of February 13, 1925, Title 28 U.S.C.A. Sec. 347, and the exercise of the sound judicial discretion to review of a matter for "special and important reasons therefor" under Supreme Court Rule No. 38, Paragraph No. 5 (b).

(3) For the filing of the petition three months after the denial of the Petition for Rehearing see 270 U.S. 151, 153, 154, *Morse v. United States*; 275 U.S. 498, *Gypsy Oil Company v. Leo Bennet Enscoe et al.*

(4) Patent cases in which discretion of this Court was exercised under Supreme Court Rule No. 38, Par. 5 (b) to grant certiorari, in the absence of direct conflict on the same patent between different Circuit Courts of Appeals (264 U.S. 314 at 319, *Keller v. Adams Campbell Co.*), but have granted certiorari in view of the importance of the question in the public interest, and for the various grounds indicated in sub-paragraph (b) of the Supreme Court Rule 38, Par. 5, and other grounds are as follows:

317 U.S. 228 at 229 *United Carbon Co. v. Binney & Smith Co.* (4th C.C.A. reversed).

- 315 U.S. 668 at 669 U.S., *Chemical Co. v. Carbide and Carbon Chemical Corp* (4 C.C.A. reversed).
- 321 U.S. 275 *Goodyear v. Ray-O-Vac Co.* (136 F. (2) 159-7 C.C.A. affirmed).
- 315 U.S. 126 at 128 *Exhibit Supply Co. v. Ace Corp* (119 F. (2) 349—modified—7 C.C.A.).
- 315 U.S. 759 at 766 *Muncie Gear Co. v. Outboard Co.* (119 F. (2) 404 reversed—7 C.C.A.)
- 324 U.S. 370 at 371 *Special Equipment Co. v. Coe.*
- 325 U.S. 79 *Hoover Co. v. Coe.*
- 325 U.S. 327 *Sinclair & Carroll Co. v. Interchemical Corp.*
- 294 U.S. *Smith v. Snow**.
- 294 U.S. *Waxham v. Smith***.

*In these two cases, no conflict between different Circuits in the finding as to the validity of the same patent existed. In 294 U.S. 1 at 3, "Certiorari was granted to review a decree of the Circuit Court of Appeals for the 8th Circuit 70 F (2) 564 which reversed the decree of the District Court and held valid but not infringed the first claim—". "The question presented here is—whether the Petitioner has drafted it in such form as to secure the fruits of his invention—"

** 294 U.S. 20 at 21 (*supra*): "In this companion case—Certiorari was granted to review a decree of the Court of Appeals for the 9th Circuit 70 F (2) 457 which affirmed the decree of the District Court and held valid and infringed the first claim * * * "The issues here, as in the Snow case, are the scope of claim 1 and its infringement as rightly construed."

In the present case, the Court of Appeals denied to the patentee the scope of claim dictated by the plain and unambiguous terms of combination claims, not met by any prior anticipating art, said claim clearly defining

Questions Raised by the Case.

(1) Is it within the power of a Federal Court to disregard the claims of a patent as granted by the properly established administrative tribunal—the Patent Office—and, without passing on validity of the claims, by judicial decree, limit their scope for the benefit of one Defendant as effectively as if the patent were legally reissued, the claims, however, as against the rest of the public standing unimpeached?

(2) Where a patent combination claim covers broadly in plain and unambiguous terms a molding machine without reference or restriction to whether the machine molds flanged caps or unflanged caps, by the use of a three-part mold or a two-part mold respectively, did the Court of Appeals violate the patent laws in this infringement suit by limiting the scope of the claim to cover the making of a flanged cap because that is what the patent specifically shows, and by restricting it to cover a three-part mold, because that also is what

means in a machine first in the art to achieve a novel function and a new result, yet even though admittedly the plain terms of the claim read upon the Defendant Stokes machine (R. p. 142 a), "of a different structure" (294 U.S. 20 at 23, *supra*) the Court needlessly and without benefit of, or any compelling requirement of prior art, limited the broad claims as if they were specifically limited to "that particular way described" in the specification as "was the best one" (294 U.S. 1 at 11, *supra*) to illustrate and exemplify one means in which the principle was applied to a flanged type cap by a 3-part mold, such a limitation by judicial intrusion being "without warrant in the record" and in callous disregard of the principles of law set forth in 294 U.S. 20 at 21, 23 *supra*, and other cases in this Court later noted.

the patent shows, and other "slender" differences where the patent and where the evidence shows such changes to be immaterial to the substance of the invention? Does the claim or does the specification and drawing measure the protection of the patent?

(3) Does this patentee not have rights to have the issue of validity passed upon where his claims, upon the evidence and admission of Defendant (R. p. 142 a), by their terms cover the Defendant's machine, or may the Court avoid the test of validity by judicially limiting the claims to cover only the specific device disclosed in the patent and thus avoid determination of the question of validity?

(4) Shall the claim be the measure of the protection afforded by a patent, or shall the claim be a "nose of wax" to be distorted and modeled by specific facts or by the Court's impression, influenced by counsel without support of evidence of record, as to the significance of differences between two structures?

(5) Does the administration of the Patent Law not require the administrative acts of the Patent Office in granting claims be given the finality of other administration determinations subject only to the power to consider or invalidate for clear mistake in the grant of the patent, in view of the defenses created by statute under R.S. 4886 (35 U.S.C.A. Sec. 31; R.S. 4920, 35 U.S.C. Sec. 69) and particularly is the Court without statutory power to effectively limit the claims beyond the clear and unambiguous import of their terms?

(6) As a matter of law, on the basis of the undisputed facts of this case and upon the face of the opinion of the Court of Appeals, and in view of the

Patent Statutes (R.S. 4886 & 4888; 35 U.S.C.A. Sec. 31 and 33) and the Federal Rules of Civil Procedure Rule 52-(a), has the Circuit Court of Appeals here rendered a decision which has so far departed from the accepted and usual course of Judicial proceedings, and so far in conflict with and inconsistent with a number of patent principles and policies thoroughly settled by decisions of this Court, and is so far "at large" and "without warrant in the record" and without "reasonable basis at law", and which is so adverse to the public interest or confidence in rights under patent claims, as to require supervisory regulation by this Court?

Reasons Relied on for Allowance of the Writ.

(1) The Court of Appeals has decided this case in a way probably not in accord with the applicable decisions of this Court; U.S.C. rule 38-5 (b) among which decisions are: *White v. Dunbar*, 119 U.S. 47 at 51-2; *Morley v. Lancaster*, 129 U.S. 263 at 274, 282, 290; *Smith v. Snow*, 294 U.S. 1; *Winans v. Denmead*, 15 How. 330 at 343; *Paper Bag Case*, 210 U.S. 405, at 416-7; 420; 423; *Parks v. Booth*, 102 U.S. 98 at 104; 294 U.S. 20 at 23, *Waxham v. Smith*; 324 U.S. 370 at 384 (note 3) *Special Equipment Co. v. Coe*.

(2) The Court of Appeals has decided an important question of general law in a way probably untenable or in conflict with the weight of authority (S. Ct. Rule 38-5 (b) and in conflict with applicable decisions of this Court, represented by *White v. Dunbar* (*supra*); *Morley v. Lancaster* (*supra*); *Smith v. Snow* (*supra*); *Paper Bag Case* (*supra*); *Milcor Steel Co. v. Fuller Co.*, 316 U.S. 143; *Reinharts, Inc. v. Caterpillar Tractor Co.*, 85 Fed. (2) 628 (C.C.A. 9); *Saco-Lowell Shops v. Reynolds*, 141 F.

(2d) 587 (C.C.A. 4); *Davis Sewing Machine Co. v. New Departure Mfg. Co.*, 217 F. 775, (C.C.A.6).

(3) The Court of Appeals has so far departed from the accepted and usual course of Judicial proceedings, or so far sanctioned such departure by the lower Court as to call for an exercise of this Court's power of supervision.

(4) It is a matter of public importance that a clear line of distinction be kept between the Administrative function of the Government—the Patent Office—and the Judicial tribunals, and where claims of a patent granted by the Patent Office are clear and unambiguous, the plain terms of the patent grant, like the terms of any other written instrument, should not be judicially "construed" to cover less than the clear language expressed in terms of the grant.

(5) It is a matter of public importance that both the patentee and the public may accept the clear, unambiguous language of the grant as the measure of the protection, and if the language of a claim be too broad, it is the duty of the Court to the public and to the patentee to so hold, and where a Court of Appeals avoids this duty, or condones a District Court in so doing by "reading into the claims" limitations not contained in the plain and unambiguous language of the claims, this Court, in the public interest, should exercise its supervisory authority.

(6) The practice of the District Court, condoned by the Circuit Court of Appeals, of arbitrarily foreclosing the trial proceedings without any fair presentation of testimony as to the prior art—and thereafter ruling that the claims should be narrowly construed in

the light of the prior art to exempt Defendant's machine—is a practice requiring supervision and regulation, and it is a matter of grave public concern that a Court may avoid its duty of fully and fairly examining the prior art to determine whether a claim is valid or invalid and superficially consider the prior art to "construe" the claim.

Wherefore Petitioners pray that the writ be granted.

WILLIAM H. PARMELEE,
EIFFEL B. GALE,
Counsel for Petitioners.

CHRISTY, PARMELEE & STRICKLAND,
1621 Farmers Bank Building,
Pittsburgh, Pennsylvania.

EDWARD A. SMITH,
802 Union Trust Building,
Baltimore, Maryland,
Of Counsel.

Sept. 14, 1946.

We, William H. Parmelee and Eiffel B. Gale, of counsel for Petitioners herein, do hereby certify that in our judgment the foregoing petition is well founded and that the same is not interposed for delay.

WILLIAM H. PARMELEE,
EIFFEL B. GALE.

The first of these is the fact that the United States is a young nation. It has only been about 150 years since it was founded. This is a very short time in the history of the world. Yet in this short time, the United States has achieved many great things. It has become a world power, a leader in science and technology, and a model of democracy. This is a testament to the strength and resilience of the American people.

Another important factor is the fact that the United States is a large country. It has a vast territory, with a long coastline and a large population. This has allowed the United States to develop a strong economy and a powerful military. It has also allowed the United States to become a global leader in many fields.

Finally, the United States has a rich cultural heritage. It is a melting pot of different cultures, languages, and traditions. This has made the United States a unique and vibrant nation. It has also allowed the United States to become a world leader in the arts and sciences.

These are just some of the reasons why the United States is a great nation. It is a nation of opportunity, of freedom, and of progress. It is a nation that has the potential to achieve even greater things in the future.

The United States is a nation of many firsts. It was the first to declare independence from a European power. It was the first to establish a federal government. It was the first to abolish slavery. And it is the first to achieve so much in such a short time.

The United States is a nation of hope. It is a nation that believes in the power of the individual. It is a nation that believes in the power of the people. It is a nation that believes in the power of the future.

BRIEF IN SUPPORT OF PETITION.

Reasons for the Granting of the Writ.

We submit that this case justifies the granting of the Writ of Certiorari because of the importance of uniformly holding to the repeatedly expressed rule of this Court that the claims, and not the specification of a patent, are the measure of the invention, and the deviation from that rule which may result if this case sets a precedent.

The action of the Court of Appeals and the District Court in disregarding and ignoring this applicable principle of law so thoroughly well established by numerous decisions of this Court, constitutes the false premise for the conclusion of non-infringement.

The failure and refusal of the Court of Appeals and the District Court to apply the claim as the measure of the invention has resulted in the decision "in a way" which, on the facts of this case, and on the face of the opinion of the Court of Appeals, is manifestly "in conflict with applicable decisions of this Court" and is so clearly without a "reasonable basis in law" and has "so far departed from the accepted usual course of judicial proceedings" as to call for an exercise of this Court's power of supervision. (S. C. Rule 38-5 (b)).

The patentee is required by law to fully and exactly claim his invention to enable the public to know what it may do without infringing upon the patent, and to preclude the patentee from claiming as his improvement more than he has invented.

In *United Carbon Co. v. Binney Co.*, 317 U.S. 228—p. 236, this Court said:

"The statutory requirement of particularity and distinctness in claims is ~~not~~^{not} only when they clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise. A zone of uncertainty which enterprise and industry may enter only at the risk of infringement of claims would discourage invention only a little less than unequivocal foreclosure of the field."

The action of the Court of Appeals in this case is to create obscurity and confusion by Judicial intrusion. Does it take one, two or four "slender" differences in the Stokes machine, from the Rahm patent, to change the meaning of the claim?

Obviously, as a matter of "horse-sense", the legal status and grammatical character or the meaning of the Rahm claims to the public cannot be changed in any way by any "mental state", Judicial or otherwise, or by any "differences".

Though the Court of Appeals found that the accumulation of several "slender" differences in toto made a "substantial" difference (R. p. 457), still this cannot alter the scope of the grant, nor is it any criteria.

The position of the Court of Appeals is in conflict with *Morley v. Lancaster*, 129 U.S. 263, p. 282, which in commenting on differences between the accused and patented structures said:

"The question is not whether the addition is material ["substantial"] or whether the omission is

material, but *whether what has been taken is the substance and the essence of the invention.*"*

If the claim of a patent cover "the machine X having the elements A, B and C", any one reading the claim may know that if he builds the machine X with these elements or their functional equivalents, he infringes. If, however, he builds the machine X with only elements A and B, or with elements A, B and D, he does not infringe.

The treatment of the instant case by the Trial Court and by the Court of Appeals disregards this elementary and fundamental concept of the claim of a patent and substitutes for the claim the Court's own conception of what the patent covers. Instead of the claim being the measure of the invention, the words of the claim mean one thing if the infringer exactly duplicates the structure shown in the patent, and they mean another thing if the infringer makes a variation.

In the present instance, Rahm was the first to conceive of the possibility of removing the molded screw-threaded products from a plastic molding press of the reciprocating bed type ("the combination with a ma-

* See also *Winans v. Denmead*, 15 How 330, p. 343 "And, therefore, the patentee, having described his invention and shown its principles, and claimed it in that form which most perfectly embodies it, is, in contemplation of law, deemed to claim every form in which his invention may be copied, unless he manifests an intention to disclaim some of those forms." Also at p. 343 "It is not a defense that it is embodied in a form not described * * * by the patentee."

Davis Sewing Machine Co. v. New Departure Mfg. Co., 217 F. 775, p. 781 "They [Defendant's differences] cut no figure on the question of infringement."

chine of the class described") by the use of thread-forming elements that could rotate in a fixed plane, i.e., they turned without moving up or down, while using the mold cavity in which the plastic article was formed as a means to keep the cap from turning with the thread-forming element so that as the thread-forming element rotated the cap would be automatically unscrewed. All of the thread-forming elements operate simultaneously so that a large number of caps may be made and unscrewed at a time. Claim 2 of the Rahm patent reads:

"In combination with a molding machine of the class described adapted to form a threaded portion in a number of objects to be simultaneously molded, of a plurality of thread forming members mounted and adapted to be rotated simultaneously in a fixed plane, and means mounted and incorporated in the molding machine for simultaneously and automatically unscrewing the thread forming members from the molded objects and ejecting the same from the molds."

The defendant uses fundamentally the same mechanism; it provides the thread-forming pin rotatable in a fixed plane in a press of this kind; it provides a mechanism by which all of these thread-forming elements may be operated at one time to simultaneously unscrew all of the pieces that are made. Instead, however, of turning the thread-forming elements until the caps have been completely unscrewed, the Defendant leaves the cap loosely dangling from the thread-forming elements and brushes them off with rubber fingers or strippers which rub against the loosely dangling caps and complete their removal. Only by using the substance of the Rahm invention in the first stage of the

unscrewing is it possible to use the rubber fingers to brush off the dangling caps. This was admitted by Defendant's counsel (R. p. 131 a).

This operation is referred to by the Circuit Court of Appeals, where it states (R. p. 456):

"Rahm is thus in the nature of a single step device in which the parts of a mold are manipulated to cause the molded caps to drop by gravity into a pan inserted between the mold plates. In Stokes a two-step procedure is employed; the threaded device merely loosening the caps which are later knocked off by the rigidly positioned rubber fingers fixed to the lower mold plate as this plate is laterally moved completely out of the mold machine."

The second step of Stokes "won't work" unless Stokes first uses the invention of Rahm to "necessarily break the adhesions and have the piece loose * * *", and the Court's use of the term "merely loosen"* gratuitously deprecates the real issue.

Also, while the Court of Appeals again gratuitously emphasized the importance of the fact that in the Stokes machine the bottom mold plate moves back and forth from a molding position to a position where it can be charged with new pre-forms, Mr. Edmonds for the De-

* While the Court used the expression "merely loosen", counsel for Defendant said: "We certainly agree that the piece is *substantially unscrewed* by the force plug and relatively in actual practice little is done by the stripper—it is not necessary. You must necessarily break the adhesions and have the piece loose, *or the strippers won't work.*" (R. p. 131 a).

fendant in colloquy with the Court (Typed R. p. 499) stated that this "has no real significance." In any event, the operation of the bottom mold plate, to which the Court gave such importance, occurs as an addition to and after the functioning of the Rahm invention. The Court of Appeals in its opinion further said (R. p.): :

"Rahm uses a three-plate mold which is essential to its operation while Stokes employs a two-part mold." *

"In Rahm the cap is held against rotation by the upper mold plate; in Stokes this is done by the lower mold plate." **

"Rahm produces a cap with a flange at the top [like those used on tooth paste tubes] which facilitates unscrewing the cap from the article to which the cap is attached; Stokes produces a cap with a rounded top without any flange." ***

* It was testified that both the two and three-part molds were known in the art prior to Rahm, and that a three-part mold was necessary to make a flanged cap, but was not necessary to make an unflanged cap. (R. p. 55 a, 31 a, 42 a).

** In both machines it is the part of the mold which forms the skirt of the cap that keeps the cap from turning." (R. p. 171 a-174 a; 58 a; 44 a, 45 a, 41 a, 75 a, 162 a; 7 a (D.C. fact finding re Def. "lower mold cavity used to hold the molded object while unscrewing takes place thus serving the same purpose as the sleeve or collar in the upper mold in the Rahm patent."

*** Rahm testified that flanged caps were most in demand at the time he made his invention, and therefore he showed a machine for making flanged caps, but Rahm stated that his machine could make any shape that the Defendant's machine could make. (R. p. 64 a). (See also Rahm patent, R. p. 187 a, page 2, column 1, "as illustrative of one object", etc. Also "This is one form of cap.")

The importance of giving effect to these differences between the patent and the accused structure in reaching a holding of non-infringement by disregarding the clear terms of the claim, is that the grant of the patent ceases to define the metes and bounds of the invention and substitutes a judicially created "zone of uncertainty".

The effect of such a procedure as this is to ignore completely the grant which the inventor secured from the Patent Office. It, by judicial construction, does the same thing as a narrow claim reissue voluntarily sought by the patentee to correct a claim that is too broad, but whereas a re-issue operates for the benefit of the entire public, the judicial restriction of the claim as effected by the Court of Appeals leaves the claims stand in their original scope, excluding, however, the Defendant's machine which has these particular differences. If some one else should make a machine like the Defendant's, but make flanged caps instead of unflanged caps, what would be the scope of the patent? If it used a three-plate mold instead of a two-plate mold, and made a flanged cap instead of an unflanged cap as does Defendant, but used the so-called two-step process, would it, or would it not be an infringement?

The Court of Appeals properly said (R. p.):

"The claims of the patents in suit must be interpreted not literally in vacuo, but rather in the light of the specification."

However this does not mean that the specifications are the measure of the invention. The correct rule is stated in *Smith v. Snow*, 294 U.S. 1, which at several places comments on the general nature of the claim and the absence of specific limitation, and this Court said (page 11):

"We may take it that, as the statute requires, the specifications just detailed show a way of using the inventor's method, and that he conceived *that particular way described was the best one*. But he is not confined to that particular mode of use since the claims of the patent, not its specifications, measure the invention. Paper Bag Patent Case, 210 U. S. 405, 419; *McCarty v. Lehigh Valley R. Co.*, 160 U. S. 110, 116; *Winans v. Denmead*, 15 How. 330, 343. While the claims of a patent may incorporate the specifications by reference, see *Snow v. Lake Shore R. Co.*, 121 U. S. 617, 630, and thus limit the patent to the form described in the specifications, it is not necessary to embrace in the claims or describe in the specifications all possible forms in which the claimed principle may be reduced to practice. *It is enough that the principle claimed is exemplified by a written description of it and of the manner of using it 'in such full, clear, concise, and exact terms' as will enable one 'skilled in the art to make, construct, compound and use the same.'*"

At pages 13-14 of the same decision, the Court condemned the practice of making the broad claims equivalent to other limited claims of the same patent, as was done by the Court of Appeals in the instant case.

The Supreme Court in *White v. Dunbar*, (cited in over 100 subsequent cases) 119 U. S. 47, at p. 51, 52, said:

"Some persons seem to suppose that a claim in a patent is like a nose of wax which may be turned and twisted in any direction by merely referring to the specifications so as to make it include something more than, or something different from what its

words express. The context may undoubtedly be resorted to and often is resorted to for the purpose of better understanding the meaning of the claims, but not for the purpose of changing it and making it different from what it is. The claims which the statutory requirements prescribe are for the very purpose of making the patentee define precisely what his invention is, and it is *unjust to the public*, as well as an *evasion of the law to construe it in a manner different from the plain import of its terms.*"

See also *Galion Iron Works v. J. D. Adams Manufacturing Co.*, 105 Fed. (2) 943 at 947, where it is stated:

"We do not question the Court's power to interpret ambiguous language of claims, but *we do not understand that the Court has the power by judicial decree to limit any claim that is not ambiguous* merely because there is an inconsistency between it and the specification * * *. Here the claim in plain and unambiguous language covers many different kinds of structures including models 50, 51 and 20.

If the claims are so broad that they cover prior art, they are invalid, and the Court in such case should not attempt to limit them in order to save them."

To the same effect see the well-known *Paper Bag Case*, 210 U. S. 405, p. 419.

"that infringement is not averted *merely* because the machine alleged to infringe may be differentiated from the patented machine, even though the invention embodied in the latter be not primary; and

second, that the description does not necessarily limit the claims."

If, because of the state of the prior art, the claims are so broad as to read on the prior art (an assumption to which we do not subscribe) we submit it was the duty of the Trial Court and the District Court to hear evidence on the question of validity of the patent, and to pass on the validity.* Contrast the *Sinclair* case with the attitude of the District Court condoned by the Circuit Court of Appeals in the case at bar. (See R. p. 143 a).

"*The Court*: I repeat—I am not interested in the prior art. I cannot see that it has more than a passing connection with this question of infringement. I don't want—in other words I don't want to sit here and listen to a question which we not only haven't reached, but which from the present state of the evidence I don't think I will be called upon to reach frankly. * * * That is my attitude in all patent cases. I do not want to hear about phases of the case which I do not think are necessary to the issue as I see it. I may be right and I may be wrong, but I always limit the trial to what is the deciding point in the case."

* See *Sinclair and Carroll, Inc., v. Interchemical Corp.*, 325 U. S. 327: "There has been a tendency among the lower Federal Courts in infringement suits to dispose of them where possible on the ground of non-infringement without going into the question of validity of the patent. (Citing cases). It has come to be recognized, however, that of the two questions validity has the greater public importance. *Cover v. Schwartz*, 133 Fed. (2) 541, and the District Court in this case followed what will usually be the better practice by inquiring fully into the validity of this patent."

The District Court in the case at bar almost demanded that counsel not go into the question of the prior art or validity, and then in its opinion (R. p. 6-9) "sought" to "construe" the claim in the light of the prior art. This practice adopted by the Trial Court and followed by the Court of Appeals (see R. p. 455) of "construing" the claim by reference to prior art patents, but without hearing evidence on the prior art fully and completely as to whether it affects the validity of the patent, should be given the close scrutiny of this Court, and should be condemned.

The Rahm patent is no "scarecrow" species of patent. It constitutes a meritorious contribution to useful knowledge.

If the claims are valid as granted, the patentee has rights by the grant to the protection as measured by the claims, and if the claims are not valid, it is the duty of the Court in the interest of the entire public, to hold them invalid. The practice in this case of disregarding the validity of the claim but, by reference to the prior art of judicially construing the claim to be restricted by the disclosure of the patent specification is an evasion of the law, and should be condemned. It destroys the confidence of the public in a patent when the claims are molded like a "nose of wax"; it is unfair to the patentee who is left in doubt as to what his patent does cover; it is unfair to the exclusive licensee, in this case the Wheeling Stamping Company, because the patent covers less than it bargained for and less than the grant expresses, but is not invalid, and it is unfair to the public because the Court holds that the patent does not cover the Stokes machine because of differences in molds

or differences in caps, and leaves the public in a "zone of uncertainty" as to what the true scope of the patent is.

For a more complete argument and discussion of the law, reference may be made to the Petition for Rehearing which was denied without comment or opinion by the Fourth Circuit Court of Appeals.

The Quasi-Paper Patent Situation.

It is not shown that Rahm is not thoroughly and completely practical. The contrary is shown. What use is the patent to a man of small means if its substance may be taken by a large manufacturer with means to develop it to its ultimate efficiency, and the manufacturer may then impeach the patent which he has appropriated as a "paper patent"?

This Court has consistently held that failure of the patented device to be commercially successful is no reason for restricting the plain and unambiguous terms of the grant. See *Hildreth v. Mastoras*, 257 U. S. 27, p. 34; *Paper Bag Case*, *supra*; and *Special Equipment Co. v. Coe*, 324 U. S. 370, 64 U.S.P.Q. 525, p. 529:

"This Court has consistently held that the failure of patentees to make use of the patented invention does not affect the validity of the patents."

In the dissenting opinion in the same case see the footnote 3, (p. 531) relative to inventors who have been unable to secure financing.

Westinghouse v. Boyden Not Applicable.

The Trial Court and the Court of Appeals rely upon *Westinghouse v. Boyden Power Brake Co.*, 170 U.S. 537 for authority, where the Defendant's machine is specifically different from the patent, to limit the claim by the disclosure of the specification.

Westinghouse v. Boyden was a peculiar case, and four judges of the Supreme Court, Justices Shiras, Brewer, Gray and McKenna, dissented from the majority opinion. The fact situation is complicated, but the claim in question was so worded that it was regarded by the Court to cover a function [result] rather than a true combination (p. 554). The Court had a choice of holding the patent invalid as functional or limited by implication to the specification, and not infringed, and chose the latter. In so doing it referred (p. 570) to the "radical departure which Boyden made from Westinghouse (not several "slender" differences) and it said (p. 568) :

"We have no desire to qualify the repeated expressions of this Court to the effect that where the invention is functional and the Defendant's device differs from that of the patentee only in form, or in a rearrangement of the same elements of a combination, he would be an infringer, even if in certain particulars, his device be an improvement upon that of the patentee. * * * Mere variation in form may be disregarded, but the substance of the invention must be there."

In the instant case, no question of functionality has been raised. The slender differences — shape of cap, numbered mold parts, sliding or non-sliding of unrelated

parts—are not variations of substance, and Westinghouse v. Boyden has no real application.

Conclusion.

We respectfully submit that in the disposition of this case the Fourth Circuit Court of Appeals has so departed from the accepted usual course of judicial proceedings and is untenable and in conflict with the weight of authority in the applicable decisions that the writ should be granted, and we submit that the granting of the writ to correct the practice of the Fourth Circuit Court of Appeals would be in the public interest and would be in the interest of creating and restoring confidence in the patent grant and finality to the administrative action of the Patent Office as the proper tribunal to determine the scope of the patent grant.

Respectfully submitted,

WILLIAM H. PARMELEE,

EIFFEL B. GALE,

Counsel for Petitioners.

CHRISTY, PARMELEE & STRICKLAND
1621 Farmers Bank Building
Pittsburgh, Pennsylvania,

EDWARD A. SMITH, Esq.

802 Union Trust Building
Baltimore, Maryland,

Of Counsel.
